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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,619	09/25/2001	Yasuhito Sone	P107390-0000	1036
4372	7590	05/09/2006	EXAMINER	
ARENT FOX PLLC 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			JABR, FADEY S	
			ART UNIT	PAPER NUMBER
			3639	

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/868,619	Applicant(s) SONE, YASUHIITO	
	Examiner Fadey S. Jabr	Art Unit 3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/18/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claim 4 has been canceled. Claims 1-3 and 5-9 have been amended. Claim 10 has been added and is presented for examination. Claims 1-3 and 5-9 remain pending and are again presented for examination.

Response to Arguments

1. Applicant's arguments filed 18 February 2006, with respect to the rejection under 35 U.S.C. section 103, have been fully considered but they are not persuasive.
2. Applicant argues that Hasset et al. fails to disclose a number-of-times-of-unitary-use storage media. Where Hasset's IVC merely stores a toll amount which is a monetary value, and is not comparable to number-of-times-of-unitary use. Examiner notes that a monetary value and a number-of-times-of-unitary-use are equivalent. For example, a person who utilizes a toll transponder with a prepaid monetary value (e.g. 40 dollars) every day through the same toll booth which deducts the same toll amount (e.g. 4 dollars round trip) from the transponder, has a designated number of times of use (e.g. 10 times). The prepaid monetary value and the number-of-times-of-unitary-use are not only comparable, but are equivalent. Therefore, the prepaid monetary value storage media in Hasset et al. is equivalent to the number-of-times-of-unitary-use storage media.
3. Applicant argues that Hasset et al. fails to disclose a storage area for storing the opening data and time of advance sale of the media, a storage area for storing the closing date and time of the advance sale, and a storage area for storing the closing date and time of ordinary sale, at least

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three different storage areas. Examiner notes that Hasset et al. discloses a storage area for the opening and closing dates and times for the advanced sale (initial toll-money-available value purchase) and the ordinary sale (amount purchased) (Col. 2, lines 17-30; Col. 18, lines 10-62). Also, Hasset et al. discloses the IVC stores the toll-money-available quantities and other data (e.g. date and time stamps) (Col. 7, lines 26-35). Further, Hasset et al. discloses whenever a date is required, fields can be date and time stamped in a year-month-day-hour-minute-second format (Col. 18, lines 19-21). Examiner also notes that duplication of parts (one storage area versus three storage areas) performs the same result. To duplicate parts for multiple effects – *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, 11; 549 F2d 833 (7th Cir. 1977); *In re Harza*, 124 USPQ 378, 380; 274 F. 2d 669 (CCPA 1960).

4. Applicant argues that Hasset et al. fails to disclose an initial value-setting means for setting the initial numbers of media with purchase dates and times; and a means for receiving purchase/application data on each medium including its purchase date and time. Examiner notes that Hasset et al. discloses an agent at a toll credit facility loading a value representative of an initial toll-money-available quantity purchased by the vehicle operator and a bi-directional communications port for reading and writing data from and to the IVC RAM (Col. 4, lines 44-61; Col. 7, lines 26-35, 64-67)

5. Applicant argues that Deaton et al. fails to disclose or suggest the feature of initial value-setting means. Examiner notes that Deaton et al. was cited to cure the deficiency of setting the initial numbers of media higher with purchase dates during an earlier time period. Deaton et al. requires a threshold to be reached so that the discount is applied to the initial purchase after the threshold as been reached (Col. 141, lines 6-18). Further, Examiner submits that it is old and

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well known in the art to apply discounts to toll collection systems as witnessed by Park et al, U.S. Patent No. 6,091,344 A1 (Col. 7, lines 29-54).

6. Applicant argues that the Office Action has failed to establish a *prima facie* case of obviousness. Examiner notes that the combination of references need only solve the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. In response to applicant's argument concerning improper motivation to combine references, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, the examiner asserts that it is not necessary that a reference actually suggest changes or possible improvements which the applicant made, as stated in In re Sheckler, 168 USPQ 716 (CCPA 1971). The Patent & Trademark Office can satisfy the burden under § 103 to establish a *prima facie* case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 5 USPQ2d 1596, 1598 (CA FC 1988). Therefore, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971).

7. Applicant has not challenged Examiner's use of Official Notice with respect to claim 3, Applicant acknowledges the claim limitations are therefore admitted prior art.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hassett et al., U.S. Patent No. 5,144,553 in view of Deaton et al., U.S. Patent No. 6,622,811 B1.

As per **Claim 1, 2 and 10**, Hassett et al. discloses a system for setting the initial available numbers of times of unitary use of prepaid available number-of-times-of-unitary-use storage media for making use of a certain toll or pay service, the initial value-setting system comprising

- a means for receiving purchase-application data on each medium including its purchase date and time through a communication network (Col. 4, lines 13-27, 44-48; Col. 17, lines 1-21),
- a storage area for storing the opening date and time of advance sale of the media (Col. 5, lines 64-4; Col. 16, lines 33-68; Col. 18, lines 10-21),
- a storage area for storing the closing date and time of the advance sale (Col. 5, lines 64-4; Col. 16, lines 33-68; Col. 18, lines 10-21),

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- a storage area for storing the closing date and time of ordinary sale, as distinct from the advance sale, of the media (Col. 5, lines 64-4; Col. 16, lines 33-68; Col. 18, lines 10-21), and
- storage area for storing a target annual sales of the media (Col. 5, lines 64-68; Col. 16, lines 33-59),
- a storage area for storing a selling price of media, a storage area for storing a toll expressed in a number of times of unitary use of the service (Col. 5, lines 64-68; Col. 16, lines 33-59),
- a storage area for storing a most preferential initial number of times of unitary use applicable to media purchased during the advance sale (Col. 5, lines 64-68; Col. 16, lines 33-59), and
- a storage area for storing the sales from the opening date and time to the purchase date and time of each medium (Col. 5, lines 64-68; Col. 16, lines 33-59),
- an initial value-setting means for setting the initial numbers of media with purchase dates and times between the opening and closing dates and times of the advance sale higher than those of media with purchase dates and times between the closing dates and times of the advance and ordinary sales (Col. 4, lines 44-61; Col. 16, lines 33-59).
- the initial value-setting means having :
 - a function f.sub.1 to calculate the number of days from the closing date and time to the purchase date and time of each media,

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- a function f.sub.2 to calculate a preferential initial number of times of unitary use at the purchase date and time of said medium based on the number of days, the most preferential initial number of times of unitary use, and the toll,
- a function f.sub.3 to calculate the ratio of the preferential initial number of times of unitary use of said medium to the target annual sales of the media, and
- a function f.sub.4 to calculate the final initial number of times of unitary use for said medium based on the ratio and the sales at the purchase date and time of said medium (Col. 17, lines 1-54).

Hassett et al. fails to explicitly disclose setting the initial numbers of media higher with purchase dates during an earlier time period. Nonetheless, Deaton et al. teaches providing incentives for customers who make purchases during earlier time periods (Col. 70, lines 11-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Hassett et al. and offer incentives for customers who made purchases in advance as disclosed by Deaton et al. because it would encourage the customer to purchase the item during the specified time period, and it greatly improves the marketing aspects of the system.

As per **Claims 3**, Hassett et al. fails to explicitly disclose a system which the initial value-setting means sets one and the same number for all media with purchase dates and times between the opening and closing dates and times. Official notice is taken that charging customers who

purchase the identical item at the same location during the corresponding time period are billed equally is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Hassett et al. to include the initial value-setting means sets one and the same number for all media with purchase dates and times between the opening and closing dates and times, because Hassett et al. discloses vehicle operators purchasing prepaid toll-money-available quantities (Col. 5, lines 64-68), one of ordinary skill in the art would be motivated to do so, because it greatly benefits the system to charge the optimum price determined by economic forces.

As per **Claim 5**, Hassett et al. further discloses a device which is a computer and provided with the initial value-setting system (Col. 16, lines 60-68; Col. 17, lines 1-21).

As per **Claims 6**, Hassett et al. further discloses a system which sets the initial available numbers of times of unitary use of the media and has a means for transmitting the initial numbers, purchase-application-data input devices each to input and transmit purchase-application data on each medium to the initial value-setting device through a communication network N, writing devices each to receive the initial number of each medium from the initial value-setting device through the communication network N and write the initial number in said medium, and rewriting devices 4 each to rewrite the remaining available number of times of unitary use of said user's medium every time each user makes use of the service (Col. 78, lines 6-68; Col. 8, lines 1-2, 24-44; Col. 16, lines 33-35, 60-67).

As per **Claim 7 and 8**, Hassett et al. further discloses a system which

- sets the initial numbers of times of unitary use of the media and has a means for transmitting the initial numbers (Col. 16, lines 60-68),
- (ii) mobile communication terminals each including a means for inputting purchase application data on a medium (Col. 4, lines 13-27, 44-48),
- a means for transmitting the purchase-application data on the medium to the initial value-setting device through a communication network, a means for receiving the initial number of the medium from the initial value-setting device through the communication network (Col. 16, lines 56-68),
- and a means for writing the initial number in the medium, and (iii) a rewriting device to rewrite the remaining available number of times of unitary use of said user's medium every time each user makes use of the service (Col. 2, lines 27-30, 41-61).

As per **Claim 9**, Hassett et al. further discloses a medium for making use of a certain toll or pay service which is a storage medium to be used in the operating system according to claim 6, and has a rewritable storage area of a number of times of unitary use (Col. 2, lines 27-30, 41-61).

Furthermore, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). A claim containing a “recitation with respect to the manner in which a claimed

apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd Pat. App. & Inter. 1987). Thus, the structural limitations of claim 1, including an initial value-setting system comprising the structural elements of a memory and a processor are disclosed in Hassett et al. as described above. Also, as described above, the functional limitations in claim 1 do not distinguish the claimed apparatus from the prior art.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner’s Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is

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respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

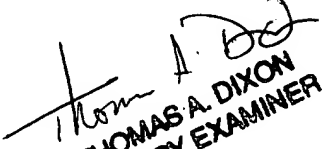
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadey S. Jabr whose telephone number is (571) 272-1516. The examiner can normally be reached on Mon. - Fri. 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Fadey S Jabr
Examiner
Art Unit 3639

FSJ


THOMAS A. DIXON
PRIMARY EXAMINER